|  |  |
| --- | --- |
| Invention Disclosure Form | Vollfl_mZNEU_li_SW |
| Please mail separately, in a sealed envelope! |
|  |  |
| To  | From |
| Technical University of MunichTUM ForTe - Office for Research and InnovationPatents and Licenses80333 Munich |  |
|
|
| Phone | E-Mail |
|  |  |
|  |  |
|  |  |
|  |  |
| To be completed by Technical University of Munich: |  |
| Received on: | Two-months period for disclosure of invention expires on: |
|  |  |
| Written confirmation of receipt sent on: | Four-months period for claiming the invention expires on: |
|  |  |
| Notification that document is incomplete sent on: | File Number: |
|  |  |
|  |  |
|  |  |
| 1. Title of the Invention: |  |
|  |  |
|  |
|  |  |
| 2. Enclosures: |  |
|  |  |
| The following documents are enclosed with the Invention Disclosure Form: |
|  |
| [ ]  ........... pages describing the invention including. ............ sketches / drawings |
|  |
| [ ]  Declaration of the Chair or the supervisor |
|  |
| [ ]  Inventor’s own work / publications in the field related to the invention |
|  |
| [ ]  Documents reflecting the prior art (publications, patent specifications, etc.) |
| [ ]  Copy / copies of third-party funded agreements / cooperative agreements |
| [ ]  ..................................................................................................................... |
|  |

|  |
| --- |
| 3. Persons who have contributed to the invention as inventors |
| Please use a separate column for each inventor. Identify external co-inventors or independent inventors as well. If there are more than three inventors, attach the required information on an additional sheet and specify as enclosure under Section 2. Inventors are defined as those individuals who have made an original creative contribution to the invention; it is not necessary, however, that the contribution as such fulfill all requirements of a patentable invention. |
|  | I herewith report the invention specified in Section 1 |
|  | [ ]  Yes | [ ]  Yes | [ ]  Yes |
| 3.1 | Last name |
|  |  |  |  |
| 3.2 | First name |
|  |  |  |  |
| 3.3 | Date of birth |
|  |  |  |  |
| 3.4 | Title / academic degree |
|  |  |  |  |
| 3.5 | Nationality |
|  |  |  |  |
| 3.6 | Home address |
|  |  |  |  |
|  |  |  |  |
| 3.7 | Phone (private) |
|  | ­­ |  |  |
|  | E-Mail (private) |
|  |  |  |  |
|  | Professional affiliation at the time the invention was made |
| 3.8 | Occupation (engineer, physician etc.) |
|  |  |  |  |
| 3.9 | Faculty/Department/School |
|  |  |  |  |
|  | Chair/Professorship |  |  |
|  |  |  |  |
|  |  |  |  |
|  | Office address |  |
|  |  |  |  |
|  |  |  |  |
| 3.10 | Phone |
|  |  |  |  |
|  | E-Mail |
|  |  |  |  |
| 3.11 | Position (Professor, research assistant / research associate/ doctoral candidate, technician etc.) |
|  |  |  |  |
| 3.12 | Employment Type (Employment contract for student research assistant, contract for work and services, teaching assignment, civil servants etc.) |
|  |  |  |  |
| 3.13 | Any changes to the above (questions 3.8-3.12) since completion of the invention? |
|  |  |  |  |
| **3.14** | Which address shall be used for the Designation of Inventor on the patent application?Designation of Inventor on the pate?  |
|  | [ ]  Home Address [ ] Office Address | [ ]  Home Address [ ] Office Address | [ ]  Home Address [ ] Office Address |

|  |
| --- |
| 4. Development of the Invention |
| 4.1 | Percentage contribution to the invention |
|  | % | % | % |
| 4.2 | The invention is within the scope of my regular job responsibilities |
|  | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No |
| 4.3 | The task leading to the development of the invention was assigned to me (e.g. within the scope of a third-party funded project) |
|  | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No |
| 4.4 | The invention originated in connection with |
| 4.4.1 | my Bachelor Thesis or Master Thesis |
|  | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No |
| 4.4.2 | my Doctoral Thesis |
|  | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No |
| 4.4.3 | my employment contract / employment relationship |
|  | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No | [ ]  Yes | [ ]  No |
| 4.4.4 | If sections 4.4.1 – 4.4.3 were answered in the negative: Did the invention arise out of |
|  | 4.4.4.a. the inventor’s own knowledge / experience? If yes, please specify? |
|  |  |  |  |
|  | 4.4.4.b. the knowledge / experience of the Chair, Institute, the TUM? If yes, please specify? |
|  |  |  |  |
| 4.5 | Date of the invention? When was the invention completed(year, month), i.e. when was it technically feasible for a skilled person to carry out the invention? |
|  |  |
| 4.6 | Did the invention arise under a cooperative / third-party funded project? If yes, which project?Please provide a copy of the collaborative agreement / third-party funds agreement, if applicable. |
|  |
| 4.7 | Was the invention developed in the course of a research and development activity on a genetic resource?If so, please describe the genetic resource. When and wherefrom was the genetic resource obtained? In case third parties obtained the genetic resource, is it known where it originally came from? If the genetic resource falls under the Nagoya Protocol, please enclose the ABS documents. |
| 5. Description of the invention |
| 5.1 Keywords Please tick off the respective keywords (see supplementary sheet keywords to classify the invention) |
| 5.2 Disclosure Please enclose a description of the invention comprising around 4 DIN A4-pages in length, or more, if necessary. Please try to address, if possible, all the points in order as stated in Enclosure 1: Guideline to describe the invention  |
| Notice: A complete and comprehensive description of the invention is important since, after a patent application has been filed, an amendment thereto will not be possible. Also, release of the invention by the TUM will be limited to the invention as reported.  |
|  |
|  |
|  |
|  |
|  |
|  |
| 6. Development status of the invention |
| 6.a. | Has the invention been tested? (idea, tests, proof of concept, samples, prototypes, maturity phase? If not, are you planning to do this?) If possible, provide a schedule. |
|  |  |
| 6.b. | Are continuing developments / advancements by the inventor(s) possible, envisaged, or planned? |
|  |  |
| 6.c. | Will the inventor’s / inventors’ professional competence remain with TUM for the short and medium term? |
|  |  |
| 7. Prior publication of parts of the invention |
| 7.a. | Has the invention been disclosed to the public in any form (in written or oral form, lectures, lab visits, trade fairs, exhibitions, etc.)? Is there a timely scheduled publication?The essential feature of the invention, i.e. its inventive content, must not have been published (not even by you) anywhere in the world prior to the application to the Patent Office. We advise you to withhold planned publications, the distribution of final papers or dissertations as well as lectures on the subject. If applicable, please include a list of planned publications, the scheduled date of publication and the type of publication (conference, journal article, doctoral thesis, trade fair, etc.). |
|  |  |
| 7.b. | Has a patent application been filed on the invention with the German Patent- and Trademark Office or another Patent Office? If yes, please enclose copies (application documentation, patent search report, search report). |
|  |  |
| 8. Commercial exploitation of the invention |
| 8.a. | Application possibilities for the invention? Potential industry sectors, products, companies, etc. Have you established contacts with the industry? |
|  |  |
| 8.b. | Have you established contacts with parties interested in your invention (please list companies, contacts, etc.)? If yes, how much has been disclosed? |
|  |  |
| 8.c. | Are you planning a spin-off? (Who is the contact person for the spin-off?) |
|  | If so: have you already contacted TUM Start-up support? Who is your relevant start-up advisor? |
|  |
| Declaration: To the best of my knowledge, no other person(s) than the person(s) listed in section 3 has / have contributed to the invention as inventor(s). I have described the invention completely and comprehensively. I am aware that any publications about the invention and any information relating thereto communicated to third parties who are not bound by a confidentiality obligation prevent the granting of intellectual property rights and must therefore be avoided. Until release of the invention by TUM I am not permitted to dispose of the invention in any manner. I did not use ChatGPT or a comparable program when filling out this form or writing the invention description. |
| Notice: The inventor will not be entitled to disclose the invention in the course of his / her research and teaching activities unless he / she has informed TUM in a timely manner, as a rule two months in advance. |
| **9. I have taken note on the information regarding data privacy (see page 3 on the further explanations)** |
|  |  |  |
| Date, signature | Date, signature | Date, signature |

**Supplementary Sheet Keywords to classify the Invention**

Please tick the box of the correct category (multiple selection possible)

|  |  |
| --- | --- |
| [ ]   | Mobility  |
| [ ]   | Digital Medicine |
| [ ]   | Artificial Intelligence |
| [ ]   | Energy – renewable energy sources, smart grids, energy efficiency, energy storage |
| [ ]   | Hydrogen |
| [ ]   | Quantum Technology  |
| [ ]   | Bio Economy  |
| [ ]   | Battery Research  |
| [ ]   | Bio Engineering |
| [ ]   | Material Science |
| [ ]   | Catalysis  |
| [ ]   | Environmental Science, Ecology  |
| [ ]   | Prevention and personalized medicine  |
| [ ]   | Medical Technology  |
| [ ]   | Neurology |
| [ ]   | Protein Science |
| [ ]   | Software Engineering |
| [ ]   | Health Science |
| [ ]   | Digital Agricultural Science |
| [ ]   | Nutrition and Food Science |
| [ ]   | Sustainability |
| [ ]   | Design |
| [ ]   | Plant Science |
| [ ]   | Data Science |
| [ ]   | Human Centered Engineering |
| [ ]   | Machine Learning |
| [ ]   | Additive Manufacturing |
| [ ]   | Robotics |
| [ ]   | Astro Physics – Structure and matter of the universe |
| [ ]   | Neutron Research |
| [ ]   | Cancer Research |
| [ ]   | Aerospace (Technology) |
| [ ]   | Climate Change |
| [ ]   | Nano Technology |
| [ ]   | Industry 4.0 |
| [ ]   | Cyber Security |
| [ ]   | Immunology and infection biology |
| [ ]   | High Performance Computing |

Declaration of the Chair or the supervisor respectively

Chair (full Professor): …………………………………………………………

Name of Chair / Institute / Research Group: …………………………………………………………

|  |
| --- |
| Invention disclosure of...................................... **Title** ..................................................................................... (date) (short term)................................................................................................................................................................................................ |
| For the validation of the legal and contractual frame-conditions please answer the following questions: |
|  |
| 1. Was the invention developed in the context of third-party funded projects? (e.g. EU, BMBF, DFG, co-operation with industry, other) |
| [ ]  No |
| [ ]  Yes - please give detailed information about the project/ project/s name and send copy/ies of contract/s |
|  |
| **2. Was the invention developed by using a genetic (not-human) resource whose access is regulated by the country of origin?** (e.g. Convention on Biological Diversity, Nagoya Protocol, others)  [ ]  No  [ ]  Yes – please give detailed information (ABS documents, etc.) |
|  |
| 3. If question 1 has been answered with yes: Was an application submitted for the refund of the costs for the patent registration / application of property rights?  |
| [ ]  No  |
| [ ]  Yes - please give detailed information (application, allocation decision, amount, etc.) |
|  |
| 4. Were resources involved for the invention that need to be reimbursed in case of a successful exploitation? To what amount? (third-party funds sponsored by funding authorities, industry partners, other) Outstanding material and financial resources, which were expended for the invention (e.g. prototype construction, special equipment acquisition) |
| [ ]  No |
| [ ]  Yes - please give detailed information |
|  |
| 5. Do you have the intention to use this invention as background IP for any third-party-funded projects? |
| [ ]  No |
| [ ]  Yes - please give detailed information |
|  |
| 6. Do you have a double affiliation? Affiliation with a partner institution. |
| [ ]  No |
| [ ]  Yes - please give detailed information (e.g. HMGU, MPG, FhG, DLR, etc.) |
|  |
| 7. I have taken note on the information about the invention. To the best of my knowledge, the data are correct. |
| .........................................., the  | ......................................................................................(Sign & Seal) |

Explanatory Notes on the Invention Disclosure Form

# You have invented something?

We encourage you to think about the legal protection and exploitation opportunities of your invention as early as possible. The longer you wait, the greater is the risk that others will get there ahead of you. Do not disclose your invention to the public. TUM ForTe Patents and Licenses provides information on any pertinent issues.

# General Purpose of the Invention Disclosure Form

# In the case of inventors whose relationship with TUM is that of an employee or a *Beamter* (civil servant) it must be established, prior to the application for intellectual property rights, who is entitled to the exploitation rights in and to the invention. This is stipulated in the German Employees’ Invention Act (ArbEG). If the invention

* is the result of your duties (commission, task) performed at the university, or
* is based substantially on the experience and knowledge and / or the work of the university,

the invention is deemed a service invention (§ 4) which may be claimed by the employer (§ 6). In this context it is **irrelevant** where or when (on the weekend, for example) the invention was made. If the university claims the invention without restriction, the university must apply for a patent without delay (§ 13). In such a case the inventor will be entitled to adequate compensation (§ 9).

Every invention which arises in the course of an employment relationship must be reported to the employer in writing completely and without delay(§ 5 and § 18). The employer shall confirm receipt of the Invention Disclosure Form to the employee promptly in writing (§ 5).

The Invention Disclosure Form is intended to enable the employer (as someone not skilled in the art) to **assess** whether or not the invention is a service invention and if yes, whether or not the employer wants to claim such invention. Such invention can be claimed by the employer in written form (§ 6). If the employer is **not** releasing the invention in written form within 4 months after receipt of the Invention Disclosure Form(important deadline!), such service invention is deemed to be claimed (§ 6 and § 8).

The documentation describing the invention must be comprehensive enough to allow TUM, in its capacity as employer, to decide if it wishes to claim the service invention and, as a consequence, wishes to apply for a patent therefor. To the extent that the invention and / or its development is not sufficiently described and explained in the Invention Disclosure Form, the employer may object to the Report within a deadline of two months (§ 5). If the employer does not object to the invention before this deadline, the invention is deemed properly disclosed. In the event of objections, the above-mentioned deadline for the claiming of an invention will be extended accordingly.

# Invention Disclosure Form

# Objective and Purpose of the Form

In order to provide legal certainty, the law expressly prescribes that inventions must be disclosed in writing. However, many inventors are not knowledgeable about how to report an invention properly. This Invention Disclosure Form (IDF) is designed to solicit specifically the information that the inventor must provide. Thus any queries and / or objections on the part of TUM ForTe Patents and Licenses may be reduced to a minimum from the outset.

An additional form provides a declaration of the inventor’s supervisor in the relevant area (as a rule, the senior Professor) unless this supervisor reports the invention himself / herself. The inventor is requested to present this form, together with the IDF documentation, to his / her supervisor r before the Invention Disclosure Form is submitted to TUM ForTe Patents and Licenses. This procedure is intended to avoid any misunderstandings between the parties involved.

Ad 2. Enclosures

Essentially, the IDF should contain only information about the inventor, the development of the invention, and the legal and financial framework. The actual technical description and explanation of the invention and any drawings shall be enclosed and specified in Section 2.

Ad 3.Joint Inventors

If several persons have contributed to the invention, it is sufficient to file a joint Invention Disclosure Form. This situation is expressly accounted for in the IDF where in section 4.1 the percentage contributions to the invention are to be indicated in order to encourage the persons involved to come to an early agreement about the percentage of their contributions to the invention.

Those inventors who report their invention / inventive contribution(s) are requested to check the applicable boxes on the chart at the top of page 2, and to sign the Invention Disclosure Form at the bottom of the last page. This does not apply to co-inventors who, only for the sake of completeness, must be listed in the chart in Section 3 by those persons reporting the invention. A signature from so called external inventors is not mandatory.

At the end of section 8 the inventors filing the IDF confirm that, except for the persons indicated, no one else has contributed to the invention as inventor. This information is required for the designation of the inventor (§ 37 of PatG[German Patent Law]) which must be submitted after having filed the patent application. Further, it is necessary for joint future patent exploitation to know about any independent inventors and / or employees of other institutions who were involved.

Those individuals must be designated as inventors who have made a substantial, inventive and original contribution to the invention.

**Please note** that your current home address is important for several reasons: on the one hand it is needed for correspondence with you pursuant to the ArbEG (you receive the claim or the release of your share of the invention to your home address). Moreover, in case of a patent application the inventors have to be named to the patent office. Some Offices (i.e. European Patent Office) send forms/confirmations to the inventors as well. In case of an exploitation of your invention (this can be years after your invention disclosure and potentially after termination of your employment) we urgently need a way to reach you for your share of inventor remuneration. Therefore, in case of an address change please give us early information about your new contact data at patent@tum.de. Incorrect or outdated addresses may result in additional costs and a delay in your inventor remuneration respectively.

## Employment Information (Sections 3.8 to 3.13)

This section requests information about the inventor’s / inventors’ employment relationships at the time the invention was­ made. Since at institutions of higher education inventions are frequently made when finishing a Bachelor’s, Master’s or doctoral thesis, it must be indicated in 3.13 where the inventor(s) may be reached after completion of the thesis.

**Information on the address in the Designation of Inventor (Section 3.14)**

Regarding the Designation of Inventor, some Patent Offices demand that the complete address of the inventor is stated. It is then disclosed in the course of the publication of the application. It is up to you whether your home address or your office address is stated on the Designation of Inventor.

Please inform us if you want to forego completely on the publication of the Designation of Inventor, with some Patent Offices a corresponding request can be filed.

## Ad 4. Development of the Invention (Sections 4.2 to 4.4 and 4.7)

In Section 4 it must be specified whether the invention evolved from an assigned task (“Aufgabenerfindung”), or from experience / knowledge (“Erfahrungserfindung”) (Sections 4.2 to 4.4).

The question concerning research projects is intended to clarify any obligations of TUM towards the providers of third-party funds. This question is asked again in the form “Declaration of the Chair or the supervisor respectively” because experience has shown that as a rule detailed information can be provided only by the supervisor.

Should the invention pertain to the field of activity of another institute or department of TUM, consideration must be given to the possibility that the invention could be used there.

Ad 4.7: If the invention is based on a genetic resource which access is regulated by the country of origin, please send us the ABS documents. Conditions for access for the respective country of origin can be found on the ABS Clearing House Website www.absch.cbd.int

## Ad 5.2 Description of the Invention

A comprehensive and complete description of the invention must be enclosed. In accordance with the structure of a patent application, the content should differentiate between the technical *problem* and the technical *solution*. The inventor is requested to provide complete information on the prior art and enclose any literature references of which he / she has knowledge (see Section 2). This will facilitate any (patent) searches to be carried out. It will be helpful to enclose or to quote the findings of the inventor’s / inventors’ own research.

When describing the invention, the inventors should focus on what is essentially new about their invention. They should indicate why it is their particular invention that solves a technical problem, or what the advantages are that their invention has over prior art. Lengthy, unsuccessful pre-trials and the explanation of the scientific basic principles may be indicated as auxiliary constituent of the Invention Disclosure Form. These do not represent the essential part of a patent application, but may contribute to the explanation of the invention.

Please note: as inventor you are an “expert in the art” – please describe your invention so that an “average person skilled in the art” can understand it. Do not provide pages filled with mathematical equations, do not describe why something works, but rather what one must do so that it works.

# Ad. 7. Pre-publication of parts of the invention

For the assessment of the patentability of an invention it is important to know whether or not parts of that invention have been made available to the public either orally or in writing (§ 3 of PatG). By signing at the bottom of this page, the inventors agree to hold information about the invention confidential until TUM releases the invention or until the patent application is filed.

Please inform us if you are planning a timely publication.

In order to avoid pre-publications that are prejudicial to novelty (shortly before trade fairs, conventions, etc.) inventors occasionally file a (provisional) patent application. In order to ensure the proper course of the patent procedure, detailed information on its status is important.

Please bear in mind that it is legally invalid to apply for a patent or utility model or to exploit the invention if the university was not involved prior to such application or exploitation.

# Ad 8. Commercial exploitation of the invention

Since patent applications are cost-intensive, the technical feasibility (see Section 6) and market opportunities for the invention (see Section 8) should be discussed at an early stage.

Inventors are permitted to, and in fact should look for potential users of their invention during each stage of technical development and through the entire process from the development of an invention until the granting of patent protection, but only to the extent that neither the content nor the nature of the invention are disclosed.

Ad 9. Information on data privacy:

The submission of your personal data serves the purpose of compliance with legal requirements, especially with the Employee Inventions Act and the Patents Act. Therefore, your personal data are stored in electronic form and will be deleted after a set period of time. Moreover, TUM may disclose your personal data to a third party in line with the patenting process or the assessment process in case it becomes necessary for the implementation of said process. Depending under which conditions your invention was developed (e.g. a third-party funded project) and which course the invention will take (filing of a patent application; commercial exploitation), the disclosure of your personal data may become necessary with regard to the following group of persons/institutions: Patent offices, patent attorney firms, patent exploitation companies (e.g. Bayerische Patentallianz) industry partners (customer/co-owner), sponsors/project execution organizations, regional financial authorities. Information on the processing of your personal data are documented in a description of the processing activity in line with the General Data Protection Regulation (GDPR). Information related to the data protection of the submitted data with regard to your invention disclosure, can be obtained from TUM ForTe P&L or the data protection officer of TUM.

# Form „Declaration of the Chair or the supervisor respectively”

Inventors who made a service / job-related invention are requested to submit this form to their immediate supervisor or other person authorized to issue directives together with the Invention Disclosure documentation.

Ad 1.: The inventor’s supervisor should be familiar with the details of third-party funded projects and their financing.

Ad 2: If the answer to that question is in the affirmative, the geographic origin of the genetic resource on which the invention is based has to be stated

Ad 3 If costs for patenting have been applied for and approved by the funding body (e.g. BMBF), this would have to be taken into account.

Ad 4.: Particular material or financial resources which were expended for the invention (for example, for the construction of prototypes in the workshops) could give rise to financial claims against the inventor.

Ad 5.: The inventors supervisor should be familiar with intended projects.

Ad 6 It is important for the legal assessment whether the chair holder has a dual function with another institution. Is there a joint appointment and/or is there a function (e.g. institute director) at HMGU, DLR, FhG, MPG or other institutions in addition to the TUM professorship?

Ad 7.: The supervisor confirms the information provided in the Invention Disclosure Form and that the supporting documentation is correct.

**Enclosure 1: Guideline to describe the invention**

1. Please specify the technical field to which the invention relates. Which technical problem does your invention attempt to solve, i.e. what is the technical purpose of your invention?
2. Please describe the prior art known to you and if possible enclose documents (publications, patents etc.) which come closest to your invention and solve a similar technical problem
3. How does your invention solve the technical problem? (Please enclose drawings, plans, sketches, example of how the invention could be performed, and other records if possible)
4. What are the essentially novel features of your invention as compared to prior art? Describe the difference between your invention and prior art
5. What advantages compared to the prior art result out of the differences described under point 4.?